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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 08/906,952 | 08/06/97 | LU | P |

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TRIAL & TECHNOLOGY LAW GROUP
PROFESSIONAL LAW CORPORATION
545 MIDDLEFIELD ROAD SUITE 220
MENLO PARK CA 94025

EXAMINER

KOZMA, T

ART UNIT

2832

PAPER NUMBER

#10

DATE MAILED: 04/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

906952

Applicant(s)

Lu et al

Examiner

T. Korne

Group Art Unit

2832

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on April 9, 1999

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 2-40 is/are pending in the application.
- Of the above claim(s) 35-40 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-35 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 2-40 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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The terminal disclaimer has been accepted and recorded.

Newly submitted claims 36-40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The article recited in claims 2-35 is not dependent upon the steps of the method of claims 36-40, but may be produced by at least one other method. For example, instead of encapsulating transformers that have pins molded into the side wall of the package, a casing could be molded over the transformers that have the pins already attached to the transformers; see *In re Ferenci* 1934 C.D.227; 68f(2)737(C.C.P.A.)

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36-40 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 2-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. From the preamble of claim 2 a package is the device claimed. In line 4 of claim 2, the transformers cannot be carried within the package; they are part of the package. In claims 6, 11, 20 and 30, the package is not one-piece; the package has many pieces.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Renskers. Applicant does not positively recite a printed circuit board (PCB); applicant's package is not mounted on a printed circuit board. Therefore, since the board is not part of the combination, it is of no moment whether the package of Renskers is subsequently mounted on top of a board or the pins of Renskers go through the board. The phrase, "for mounting onto the surface of a printed circuit board" does not mean that the package is mounted on a printed circuit board. The pins 38 can be mounted on top of a PCB or can extend through holes of PCB; the claims neither include or exclude such an arrangement. Intended use has no patentable significance. Claim 19 does not define the plurality of "terminal pins molded within the side wall" as indicated by applicant. Claim 19 merely has "a plurality of terminal pins molded within the package" as clearly seen in Fig. 6 of Renskers, the encapsulant above resilient foam 60 has the pins 32 molded within the package. Applicant's claim language does not exclude the leg connection 42 from being encapsulated or molded. Claim 19 also does not have the solder joints below the bottom of the side wall. Even so, the post ends extend beyond the bottom end of the side wall; the bottom end of side walls 28 extends to a height less than the depression 22 and the posts extend beyond the bottom end of the side wall. This is true even if joints 42 are folded back into the cavity and encapsulated. The encapsulation is not excluded by applicant's claim language. Also, the ends 42 are below and beyond the bottom of the side walls.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-18 and 21-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Renekers taken with Matsumura et al. The above discussion of Renskers herein applies. It could be argued that the encapsulant above 60 molds the terminals within the side walls 12, 28 of Renskers; however, Matsumura et al have terminal pins molded in side walls 35b. In order to provide a firm anchor for the terminals of Renskers, it would have been obvious to mold the terminals 32 in the side wall 12 of Renskers in the manner of Matsumura et al.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Kozma whose telephone number is (703) 308-1326. The examiner can normally be reached on Monday-Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Gellner, can be reached on (703) 308-1721. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

Kozma/dc
June 21, 1999



THOMAS J. KOZMA
PRIMARY EXAMINER
ART UNIT 2832